



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,488	02/27/2002	Tetsushi Kobayashi	1341.1121	6513

21171 7590 07/20/2006

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

ALLEN, WILLIAM J

ART UNIT PAPER NUMBER

3625

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/083,488	Applicant(s) KOBAYASHI ET AL.	
	Examiner William J. Allen	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History Summary

Claims 1 and 3-14 are pending per applicant's amendment filed 6/27/2006.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/27/2006 has been entered.

Response to Arguments

Applicant's arguments, see page 1, filed 6/27/2006, with respect to US Patent Publication 2002/0072974 to Pugliese, III et al. have been fully considered and are persuasive. The rejections of claims 9, 10, 12, 13, and 14 under 35 U.S.C. 102(e) and claims 1 and 3-8 under 35 U.S.C. 103(a) have been withdrawn.

Regarding claims 7 and 8, Applicant's arguments filed 6/27/2006 have been fully considered but they are not persuasive. The Examiner notes that Peterson shows a system for managing inventory levels across multiple vendors and provides for transferring items from vendors with a quantity of items available to a vendor in need of the item (see at least: abstract). The Examiner further disagrees with Applicant's

Art Unit: 3625

assertion that Peterson fails to show transferring, and thereby performing a shipping process, for the items in need "when the purchaser selects the product that is not in the inventory from the product catalog". Peterson goes so far as to state that "MRO supplies are traditionally transferred from a manufacturer to end users (customers needing MRO supplies for maintaining equipment, rather than for resale) through a network of vendors (see: 0002). Peterson also states that vendors are franchised to supply MRO supplies for specific manufacturers within defined geographic areas to end users/customers (i.e. purchasers) who desire to purchase those supplies. In the instance that a vendor does not have an item on hand (i.e. out of stock) desired for purchase by an end user, the vendor may find that another vendor will have the part in inventory, and be able to sell the part to the vendor for resale to the end user on an expedited basis (see at least: 0002). Thereby, Peterson shows performing a shipping process for the items in need "when the purchaser selects the product that is not in the inventory from the product catalog" (see at least: 0002, 0027, 0038).

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 9 and 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be

Art Unit: 3625

statutory in most cases since use of technology permits the function of the descriptive material to be realized. Claims 9 and 10 fail to recite a computer program that is embodied on a computer-readable medium. The claim is merely directed to a computer program per se. The Examiner notes that the preamble of claims 9 and 10 should resemble the preamble of claims 11 and 12.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 7-8, 10, 12, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Peterson et al. (US 2001/0011232, herein referred to as Peterson).**

Regarding claim 7, Peterson teaches:

managing information regarding products that are not in the inventory in each store, the product that is not in inventory being a product that is out of stock (see at least: abstract, 0001, 0004, 0031-0033, 0042, 0137, Fig. 1, 2, and 4); The Examiner notes that managing information on the quantity of items in inventory of each vendor encompasses managing information on products that are out of stock. Additionally, the system and methods of Peterson manage inventory information for vendors having a supply of an item in need (i.e. out of stock) by another vendor.

performing a shipment process of ordering the product selected by the purchaser from another store in which the product is available to a store in which the product is not in inventory when the purchaser selects the product that is not in inventory from the product catalog of one store (see at least: abstract, 0001-0004, 0031-0033, 0137).

Regarding claim 8, Peterson teaches *managing information regarding stock shortage products for each store, the stock shortage products being a product that is out of stock in one particular store but that is available in another store and performing shipping processing of ordering products for another store based on the information regarding the stock shortage products* (see at least: abstract, 0001-0004, 0031-0033, 0042, 0137, Fig. 1-4).

Regarding claim 10, Peterson teaches:
managing information regarding products that are not in the inventory for a plurality of stores (see at least: abstract, 0001-0004, 0031-0033, 0137);
shipping a product selected by a purchaser from a second store in which the product selected by the purchaser is available when a purchaser selects a product that is not in inventory from a catalog of a first store (see at least: abstract, 0001-0004, 0031-0033, 0137).

Regarding claims 12 and 14, claims 12 and 14 closely parallel the limitations of claims 7-8 and 10. Claims 12 and 14 are thereby rejected under the same rationale.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1, 3-6, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chao et al. (US 2002/0128918, herein referred to as Chao) in view of PTO 892 reference U (herein referred to as 892u).**

Regarding claim 1, Chao teaches:

managing information regarding products that are not in the inventory in each store, the product that is not in inventory being a product that is out of stock (see at least: abstract, 0005, 0012, 0009, 0014, Fig. 2);

updating the information regarding the products that are not in inventory in the each store using selection of a product catalog by a purchaser as a trigger (see at least: abstract, 0001, 0005, 0009, 0012, 0014-0015, claims 1, 3, 7, 11, 12, and 16).

Chao, however, does not expressly teach *introducing a purchaser to a second store in which a product selected by a purchaser is available when the purchaser selects a product that is not in inventory from a catalog*. 892u teaches *introducing a purchaser to a second store in which a product selected by a purchaser is available when the purchaser selects a product that is not in inventory from a catalog* (see at least: Paragraphs 1, 53, 57-58, and 80). It would have been obvious to one of ordinary

Art Unit: 3625

skill in the art at the time of invention to have modified the invention of Chao to have included *introducing a purchaser to a second store in which a product selected by a purchaser is available when the purchaser selects a product that is not in inventory from a catalog* as taught by 892u in order to provide referral channels that provide financial gains in addition to the natural gains in goodwill from serving customers for both referrers and referees (see at least: 892u, Paragraphs 46 and 48).

Regarding claim 3, Chao teaches managing information regarding stock shortage products for each store, the stock shortage product being a product that is out of stock in one particular store but that is available in another store (see at least: abstract, 0001, 0005, 0009, 0012, 0014-0015, claims 1, 3, 7, 11, 12, and 16). Chao, however, does not expressly teach *wherein the purchaser is introducing to another store based on the information regarding the stock shortage products*. 892u teaches *wherein the purchaser is introducing to another store based on the information regarding the stock shortage products* (see at least: Paragraphs 1, 11, 53, 57-58, and 80). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Chao to have included *wherein the purchaser is introducing to another store based on the information regarding the stock shortage products* as taught by 892u in order to provide referral channels that provide financial gains in addition to the natural gains in goodwill from serving customers for both referrers and referees (see at least: 892u, Paragraphs 46 and 48).

Regarding claim 4, Chao teaches *updating the information regarding the stock shortage for each store using selection of a product from the product catalog by a purchaser as a trigger* (see at least: abstract, 0001, 0005, 0009, 0012, 0014-0015, claims 1, 3, 7, 11, 12, and 16).

Regarding claim 5, Chao teaches all of the above but does not teach *payment of fee by another store to which the purchaser has been introduced to the store from whose product catalog the purchaser has selected the product that is not in inventory*. 892u teaches *payment of fee by another store to which the purchaser has been introduced to the store from whose product catalog the purchaser has selected the product that is not in inventory* (see at least: Paragraphs 1, 53, 58-57, and 80). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Chao to have included *payment of fee by another store to which the purchaser has been introduced to the store from whose product catalog the purchaser has selected the product that is not in inventory* as taught by 892u in order to provide referral channels that provide financial gains in addition to the natural gains in goodwill from serving customers for both referrers and referees (see at least: 892u, Paragraphs 46 and 48).

Regarding claim 6, Chao in view of 892u teaches all of the above as noted and further teaches using back orders to fulfill customer orders (see at least: abstract). Chao in view of 892u also teaches *selecting the step of introducing the purchaser to another*

Art Unit: 3625

store (see at least: 892u, Paragraphs 1, 11). Chao in view of 892u, however, does not expressly teach placing an order for the product that is not in inventory that has been selected by the purchaser *to a manufacturer*. Peterson teaches placing an order for the product that is not in inventory that has been selected by the purchaser *to a manufacturer* as well as *and selecting the step of placing the order to the manufacturer* (see at least: 0002, 0027, 0034). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Chao in view of 892u to have included placing an order for the product that is not in inventory that has been selected by the purchaser *to a manufacturer* as taught by Peterson in order to provide a system to maintain a supply network and an information network for selectively distributing information about inventory levels and pricing among vendors, thereby allowing the efficient transfer of inventory between parties (see at least: Peterson, 0004).

Regarding claim 11, claims 11 closely parallel the limitations of claim 1. Claim 11 is thereby rejected under the same rationale.

7. Claims 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson in view of 892u.

Regarding claim 9, Peterson teaches all of the above including further teaches *managing information regarding products that are not in the inventory for a plurality of stores* as notes and additionally teaches using other vendors to provide for needed supply (see at least: abstract, 0001-0004, 0031-0033, 0137). Peterson, however, does not expressly teach *introducing a purchaser to a second store in which a product selected by a purchaser is available when the purchaser selects a product that is not in inventory from a catalog*. 892u teaches *introducing a purchaser to a second store in which a product selected by a purchaser is available when the purchaser selects a product that is not in inventory from a catalog* (see at least: Paragraphs 1, 53, 57-58, and 80). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Peterson to have included *introducing a purchaser to a second store in which a product selected by a purchaser is available when the purchaser selects a product that is not in inventory from a catalog* as taught by 892u in order to provide referral channels that provide financial gains in addition to the natural gains in goodwill from serving customers for both referrers and referees (see at least: 892u, Paragraphs 46 and 48).

Regarding claim 13, claim 13 closely parallels the limitations of claim 9. Claim 13 is thereby rejected under the same rationale.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Katz et al. (US 2002/0178077) discloses inventory management with referral to additional sources of items such as different or alternative suppliers

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogesh Garg can be reached on (571) 272-6756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
Patent Examiner
July 11, 2006


Primary Examiner